

REMARKS

Regarding the status of the present application, Claims 8 and 16 have been canceled, Claims 1, 9, and 17 have been amended, Claims 18 and 19 have been added, and Claims 1-7, 9-15 and 16-19 are pending in this application. Reconsideration of this application is respectfully requested.

Claims 1, 2, 4, 5, 9, 10, 12, 13, and 17 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over US Design Patent No. D226,526 issued to Cicero.

It is respectfully submitted that Claims 1, 2, 4, 5, 9, 10, 12, 13 and 17 are not anticipated under 35 U.S.C. § 102(b) by the Cicero design patent. As was admitted by the Examiner, the Cicero patent does not disclose or suggest a putter or a shaft. Therefore, it is respectfully submitted that the Cicero design patent cannot possibly anticipate the present invention.

With regard to the obviousness rejection under 35 U.S.C. § 103(a), independent Claims 1, 7 and 17 have been amended to more clearly distinguish over the Cicero design patent.

Amended Claim 1 calls for a putter comprising:

a shaft having a grip disposed at an upper end;
a putter head disposed at a lower end of the shaft that comprises:
a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body and that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface, a base extending toward a rear end of the body, and a cavity formed behind the ball contact surface and lateral portions and above the base.

It is respectfully submitted that it appears that the Examiner has misunderstood what is disclosed in the Cicero design patent. The Cicero design patent clearly states that Fig. 3 is a front view of the putter head. Therefore, with reference to Fig. 1, the putter head tapers from the front portion of the head inwardly toward the rear end, terminating at a relatively small rear surface. Thus, the front ball contact surface of the Cicero putter head is between the lateral frontwardly extending "skirts" or edges of the putter head (i.e., the downwardly extending extensions shown in Fig. 1 of the Cicero design patent). The Examiner has mischaracterized the teachings of the Cicero design patent and has argued that the ball contact surface is the rear end of the putter head. The structure of the Cicero design patent is backwards from that of the present invention.

It is respectfully submitted that the Cicero design patent does not disclose or suggest that the putter head has a "flat ball contact surface that extends the full height of the body", or "a base extending toward a rear end of the body", or "a cavity formed behind the ball contact surface and lateral portions and above the base", as is recited in Claim 1. Looking at Fig. 2 of the Cicero design patent reveals that the front surface of the putter head is flat at the upper portion and is curved at the bottom portion. Furthermore, since the Cicero patent is a design patent, it would not be obvious to modify the structure of the putter head to make the ball contact surface entirely flat. Also, the Cicero patent does not disclose or suggest either a base extending

toward a rear end of the body, or a cavity formed behind the ball contact surface and lateral portions and above the base. Independent Claims 9 and 17 recite substantially the same subject matter as is recited in Claim 1.

Therefore, it is respectfully submitted that the subject matter recited in Claims 1, 9 and 17 are not disclosed or suggested by the Cicero design patent. Withdrawal of the Examiner's rejection and allowance of Claims 1, 9 and 17 are respectfully requested.

Claims 2, 4, 5, 10, 12 and 13 are considered patentable based upon the allowability of Claims 1 and 9. Therefore, it is respectfully submitted that the invention recited in Claims 2, 4, 5, 10, 12 and 13 are not disclosed or suggested by the Cicero design patent. Withdrawal of the Examiner's rejection and allowance of Claims 2, 4, 5, 10, 12 and 13 are respectfully requested.

Claims 1, 2, 4, 5, 7, 9, 10, 12, 13, 15 and 17 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over US Design Patent No. D282,952 issued to Mattingly.

It is respectfully submitted that Claims 1, 2, 4, 5, 7, 9, 10, 12, 13, 15 and 17 are not anticipated under 35 U.S.C. § 102(b) by the Mattingly design patent. As was admitted by the Examiner, the Mattingly patent does not disclose or suggest a putter or a shaft. Therefore, it is respectfully submitted that the Mattingly design patent cannot possibly anticipate the present invention.

With regard to the obviousness rejection under 35 U.S.C. § 103(a), independent Claims 1, 7 and 17 have been amended to more clearly distinguish over the Mattingly design patent.

With regard to amended Claim 1, it is respectfully submitted that the Mattingly design patent does not disclose or suggest that the putter head has a "a base extending toward a rear end of the body", or "a cavity formed behind the ball contact surface and lateral portions and above the base", as is recited in Claim 1. The Mattingly putter head has no base extending toward a rear end of the body and there is no cavity formed behind the ball contact surface and lateral portions and above the base. Contrary to the present invention, a triangular portion of the top surface of the putter head is raised above the level of the remainder of the top surface of the putter head, there is a linear raised member along the center line of the head that is raised above the level of the triangular portion, and there is a raised back edge that is at the level of the linear raised member. This is not what is recited in Claim 1. Independent Claims 9 and 17 recite substantially the same subject matter as is recited in Claim 1.

Therefore, it is respectfully submitted that the subject matter recited in Claims 1, 9 and 17 are not disclosed or suggested by the Mattingly design patent. Withdrawal of the Examiner's rejection and allowance of Claims 1, 9 and 17 are respectfully requested.

Claims 2, 4, 5, 9, 10, 12, 13 and 15 are considered patentable based upon the allowability of Claims 1 and 9. Therefore, it is respectfully submitted that the invention recited in Claims 2, 4, 5, 9, 10, 12, 13 and 15 are not disclosed or suggested by the Mattingly design patent. Withdrawal of the Examiner's rejection and allowance of Claims 2, 4, 5, 9, 10, 12, 13 and 15 are respectfully requested.

Claims 3, 6, 11 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Design Patent No. D226,526 issued to Cicero. It is respectfully submitted that it should be clear from the above discussion that the Cicero design patent does not disclose or suggest the subject matter recited in Claims 1 and 9. As was argued above, the structure of the Cicero putter head is backward compared to the present invention. The relatively small surface of the Cicero putter head is at the rear of the head, not the front.

The Examiner's statement that "Applicant has not disclosed criticality or unexpected results for having curved surfaces versus flat surfaces in the lateral portions" is not relevant to what the Cicero design patent does or does not disclose. Since the lateral surfaces of the present invention are tapered away from the front sweet spot, if the ball contacts either of these surfaces during putting, the ball will be diverted laterally. Both flat and curved lateral surfaces achieve this result, and the results are expected.

Claims 3 and 11 recite that "the shaft has an offset." The Cicero design patent does not disclose or suggest a shaft or a putter, and is only directed to a putter head. Since there are no shafts disclosed or suggested by the Cicero design patent, it is respectfully submitted that the assertion that the use of an shaft having an offset with the Cicero putter head is necessarily based upon hindsight reconstruction. There is no disclosure or suggestion contained in the Cicero design patent regarding the use of any type of shaft.

Therefore, it is respectfully submitted that the subject matter recited in Claims 3 and 11 are not disclosed or suggested by the Cicero design patent. Withdrawal of the Examiner's rejection and allowance of Claims 3 and 11 are respectfully requested.

Claims 6 and 14 are considered patentable based upon the allowability of Claims 1 and 9. Furthermore, there is no disclosure or suggestion contained in the Cicero design patent that the putter had has lateral portions of the front surface that are curved surfaces. Furthermore, the tapered lateral portions face rearwardly in the Cicero putter head.

Therefore, it is respectfully submitted that the inventions recited in Claims 6 and 14 are not disclosed or suggested by the Cicero design patent. Withdrawal of the Examiner's rejection and allowance of Claims 6 and 14 are respectfully requested.

Claims 7 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Design Patent No. D226,526 issued to Cicero in view of US Design Patent No. D234,962 issued to Swash. Claims 7 and 15 recite that "the putter head has a flat base with relatively thick lateral ends, one of which has an opening therein into which the shaft is inserted."

The Examiner's position is that "Cicero '526 discloses a relatively thick lateral ends but fails to disclose one of which has an opening to receive a shaft. Swash '962 teaches lateral portions with openings to facilitate shaft attachment for both left-hander and right-hander (Figs. 2-3). "

It is respectfully submitted that the Cicero design patent discloses a putter head that is backward compared to the present invention. It is respectfully submitted that the Cicero patent does not disclose or suggest a putter head having a flat base. The Cicero patent does not appear

to have a base. Also the Cicero patent does not disclose or suggest that the putter head has a flat base with relatively thick lateral ends, one of which has an opening therein into which the shaft is inserted. The Cicero patent clearly shows in Fig. 1 that that the shaft opening is centered in the rear portion of the putter head.

There is absolutely no disclosure or suggestion contained in the Cicero design patent regarding the desirability of modifying the putter head to provide an opening in a lateral end into which a shaft is inserted. The clear intent of the Cicero design patent is to have a centrally located putter shaft inserted into an opening located along the center line of the putter head near its rear end. Any assertion by the Examiner to the contrary, or modifying the teachings of the Cicero design patent to have shaft opening located at lateral locations in the head improperly extends the teachings of the Cicero design patent beyond its scope and amounts to hindsight reconstruction on the part of the Examiner.

Claims 7 and 15 are also considered patentable based upon the allowability of Claims 1 and 9 from which they depend. Therefore, it is respectfully submitted that the inventions recited in Claims 7 and 15 are not disclosed or suggested by the Cicero and Swash design patents, taken singly or together. Withdrawal of the Examiner's rejection and allowance of Claims 7 and 15 are respectfully requested

Claims 8 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Design Patent No. D226,526 issued to Cicero in view of US Patent No. 5,769,737 issued to Holliday et al. and US Design Patent No. D234,962 issued to Swash. Claims 8 and 16 have been canceled and so this rejection is considered moot.

However, with regard to amended Claims 1 and 9, the subject matter recited in Claims 8 and 16 has been respectively incorporated therein. It is respectfully submitted that this combination of references does not disclose or suggest the subject matter recited in amended Claims 1 and 9.

With regard to Claim 1, the Cicero design patent, Holliday et al. patent, and Swash design patent, taken singly or together, do not disclose or suggest a putter body "having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body." This is abundantly clear from looking at the drawing figures of the respective patents.

As was argued above, the Cicero putter head tapers from the front portion of the head inwardly toward the rear end, terminating at a relatively small rear surface. The ball contact surface of the Cicero putter head is between the lateral frontwardly extending "skirts" or edges of the putter head. The structure of the Cicero design patent is backwards from that of the present invention.

As was admitted by the Examiner, the Cicero design patent "does not disclose" that "a rear portion of the putter head has a cavity." Furthermore, it is respectfully submitted that the Cicero design patent does not disclose or suggest a "base extending toward a rear end of the body, and a cavity formed behind the ball contact surface and lateral portions and above the

base." The Cicero putter head does not have a base and cavity as is disclosed in the present application and recited in Claims 1 and 9.

The Examiner stated that the Swash design patent "teaches rear portion having a cavity to reduce the overall weight of the putter head." The Swash design patent discloses a putter head having upper and lower cavities (shown in Figs. 4 and 5). However, there is no flat base in the Swash putter head. Therefore, it is respectfully submitted that the Swash design patent also does not disclose or suggest a putter body having "a base extending toward a rear end of the body", or "a cavity formed behind the ball contact surface and lateral portions and above the base" as is recited therein.

The Holliday et al. patent discloses a "golf club head, and particularly a putter head, having a generally horizontally disposed weight receiving cavity which extends longitudinally and laterally within the club head, and one or more weight members having weight securing means to releasably attach the weight members within the weight receiving cavity at any position laterally or longitudinally within the weight receiving cavity." The Examiner cited column 3, lines 44-50 as disclosing that a "large surface cavity 17 removes unnecessary weight from the club head 10 to reduce weight of the putter head." However, the Holliday et al. patent discloses a conventional putter head with no small sweet spot or tapering lateral portions.

Also, modifying the Cicero putter head to include features disclosed in the Holliday et al. patent or Swash design patent does not produce the present invention. This is because the design of the Cicero putter head is backwards from that of the present invention.

It is respectfully submitted that there is no disclosure or suggestion contained in the cited patents that would provide for their combination. This is derived using hindsight reconstruction by the Examiner, using the teachings of the cited patents in light of the teachings of the present application. Furthermore, as was stated above, none of the cited patents, taken singly or together, disclose or suggest a putter body "having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body." This is only taught in the present application.

Therefore, and in view of the above, it is respectfully submitted that the Cicero design patent, Holliday et al. patent, and Swash design patent, taken singly or together, do not disclose or suggest the inventions recited in Claims 1 and 9.

Claims 3, 6, 11, and 14 are rejected under 35 U.S.C. § 103(a) as obvious over US Design Patent No. D282,952 issued to Mattingly.

In view of the above, arguments it is respectfully submitted that the Mattingly design patent does not disclose or suggest the subject matter recited in Claims 1 and 9. It is respectfully submitted that the Mattingly putter head has no base extending toward a rear end of the body and there is no cavity formed behind the ball contact surface and lateral portions and above the base. The Mattingly putter head has a triangular portion extending from the top surface that is raised above the level of the remainder of the top surface of the putter head, there

is a linear raised member along the center line of the head that is raised above the level of the triangular portion, and there is a raised back edge that is at the level of the linear raised member.

With regard to the Examiner's statement that "Regarding claims 3 and 11, it is conventional to provide a offset to a shaft member and it would have been obvious to do so here to facilitate alignment of the putter head with ball," it is respectfully submitted that there is no shaft or putter disclosed in the Mattingly design patent, only a putter head. Any assertion by the Examiner regarding anything added to the Mattingly putter head is mere conjecture and amounts to hindsight reconstruction.

The Examiner's statement that "Applicant has not disclosed criticality or unexpected results for having curved surfaces versus flat surfaces in the lateral portions" is not relevant to what the Mattingly design patent does or does not disclose. Since the lateral surfaces of the present invention are tapered away from the front sweet spot, if the ball contacts either of these surfaces during putting, the ball will be diverted laterally. Both flat and curved lateral surfaces achieve this result, and the results are expected.

Claims 3 and 11 recite that "the shaft has an offset." The Mattingly design patent does not disclose or suggest a shaft or a putter, and is only directed to a putter head. Since there are no shafts disclosed or suggested by the Mattingly design patent, it is respectfully submitted that the use of an shaft having an offset with the Mattingly putter head is based upon hindsight reconstruction. There is no disclosure or suggestion contained in the Mattingly design patent regarding the use of any type of shaft.

Therefore, it is respectfully submitted that the subject matter recited in Claims 3 and 11 are not disclosed or suggested by the Mattingly design patent. Withdrawal of the Examiner's rejection and allowance of Claims 3 and 11 are respectfully requested.

Claims 6 and 14 are considered patentable based upon the allowability of Claims 1 and 9. Therefore, it is respectfully submitted that the invention recited in 6 and 14 are not disclosed or suggested by the Mattingly design patent. Withdrawal of the Examiner's rejection and allowance of Claims 6 and 14 are respectfully requested.

Claims 8 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Design Patent No. D282,952 issued to Mattingly in view of US Patent No. 5,769,737 issued to Holliday et al. and US Design Patent No. D234,962 issued to Swash. Claims 8 and 16 have been canceled and so this rejection is considered moot.

However, with regard to amended Claims 1 and 9, the subject matter recited in Claims 8 and 16 has been respectively incorporated therein. It is respectfully submitted that this combination of references does not disclose or suggest the subject matter recited in amended Claims 1 and 9.

As was admitted by the Examiner, the Mattingly design patent "does not disclose that "a rear portion of the putter head has a cavity." It is respectfully submitted that the Mattingly design patent discloses a putter head that is solid with no cavities and actually has a raised upper surface. It is respectfully submitted that the Mattingly putter would not be modified to add a

cavity as recited in Claims 8 and 16. There is clearly no disclosure or suggestion contained in the Mattingly design patent regarding the desirability of having a cavity in the putter. It is respectfully submitted that this rejection by the Examiner is based upon hindsight reconstruction.

Furthermore, it is respectfully submitted that the Mattingly design patent does not disclose or suggest a "base extending toward a rear end of the body, and a cavity formed behind the ball contact surface and lateral portions and above the base." The Mattingly putter head does not have a base and cavity as is disclosed in the present application and recited in Claims 1 and 9. The Mattingly putter head does not have a cavity, and there is no disclosure or suggestion in the Mattingly design patent that it would be desirable to have one.

The Examiner stated that the Swash design patent "teaches rear portion having a cavity to reduce the overall weight of the putter head." The Swash design patent discloses a putter head having upper and lower cavities (shown in Figs. 4 and 5). However, there is no flat base in the Swash putter head. Therefore, it is respectfully submitted that the Swash design patent also does not disclose or suggest a putter body having "a base extending toward a rear end of the body", or "a cavity formed behind the ball contact surface and lateral portions and above the base" as is recited therein.

The Holliday et al. patent discloses a "golf club head, and particularly a putter head, having a generally horizontally disposed weight receiving cavity which extends longitudinally and laterally within the club head, and one or more weight members having weight securing means to releasably attach the weight members within the weight receiving cavity at any position laterally or longitudinally within the weight receiving cavity." The Examiner cited column 3, lines 44-50 as disclosing that a "large surface cavity 17 removes unnecessary weight from the club head 10 to reduce weight of the putter head." However, the Holliday et al. patent discloses a conventional putter head with no small sweet spot or tapering lateral portions.

It is respectfully submitted that there is no disclosure or suggestion contained in the cited patents that would provide for their combination. This is derived using hindsight reconstruction by the Examiner, using the teachings of the cited patents in light of the teachings of the present application.

Furthermore, it is respectfully submitted that the Mattingly design patent does not disclose or suggest a putter body "having a front surface with a relatively small, centrally-located, flat ball contact surface." The ball contact surface disclosed in the Mattingly design patent is at least one-third of the width of the putter head. This is not a "relatively small" ball contact surface, it is a relatively large one.

The reason that this is so is that the Mattingly putter head is designed to be used as a putter during a golf round, whereas the present invention is designed as a practice putter. The idea is to practice with a putter having a small contact area so that the stroke becomes more accurate, and then use a regular putter with a relatively large contact surface during a golf round.

In view of the above, it is respectfully submitted that the Mattingly design patent, Holliday et al. patent, and Swash design patent, taken singly or together, do not disclose or suggest the inventions recited in Claims 1 and 9.

Newly added Claims 18 and 19 recite "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface extending substantially the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface." It is respectfully submitted that there is no disclosure or suggestion contained in any of the cited patents regarding a putter head having a flat ball contact surface extending substantially the full height of the body that is about 5/8 to 1/2 inches in width.

In particular, the ball contact surface of the Mattingly putter head is much larger than 1/8 to 1/2 inches in width and is about one third of the width of the putter head. The ball contact surface of the Cicero putter head is almost the entire width of the putter head. The ball contact surface of the Swash putter head is the entire width of the putter head. The ball contact surface of the Holliday et al. putter head is the entire width of the putter head.

Therefore, it is respectfully submitted that Claims 18 and 19 are not disclosed or suggested by any of the cited prior art patents, taken singly or together. Allowance of Claims 18 and 19 is respectfully requested.

The prior art heretofore made of record and not relied upon is considered pertinent to applicant's disclosure to the extent indicated by the Examiner.

In view of the above, it is respectfully submitted that all pending Claims are allowable over the art of record and that the present application is in condition for allowance. Reconsideration and allowance of this application are earnestly solicited.

Respectfully submitted,

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In view of the above, it is respectfully submitted that the Mattingly design patent, Holliday et al. patent, and Swash design patent, taken singly or together, do not disclose or suggest the inventions recited in Claims 1 and 9.

Newly added Claims 18 and 19 recite "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface extending substantially the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface." It is respectfully submitted that there is no disclosure or suggestion contained in any of the cited patents regarding a putter head having a flat ball contact surface extending substantially the full height of the body that is about 5/8 to 1/2 inches in width.

In particular, the ball contact surface of the Mattingly putter head is much larger than 5/8 to 1/2 inches in width and is about one third of the width of the putter head. The ball contact surface of the Cicero putter head is almost the entire width of the putter head. The ball contact surface of the Swash putter head is the entire width of the putter head. The ball contact surface of the Holliday et al. putter head is the entire width of the putter head. It is respectfully submitted that none of these conventional putter heads are designed or would be modified to have a sweet spot that is about 5/8 to 1/2 inches in width. This is because none of the cited prior art patents discloses a practice putter head, they are all normal putters for use during play.

Therefore, is respectfully submitted that Claims 18 and 19 are not disclosed or suggested by any of the cited prior art patents, taken singly or together. Allowance of Claims 18 and 19 is respectfully requested.

The prior art heretofore made of record and not relied upon is considered pertinent to applicant's disclosure to the extent indicated by the Examiner.

In view of the above, it is respectfully submitted that all pending Claims are allowable over the art of record and that the present application is in condition for allowance. Reconsideration and allowance of this application are earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kenneth W. Float", with a stylized flourish at the end.

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